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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/634,261
Filing Date: August 05, 2003
Appellant(s): BALDIGA ET AL.

_____

Hunter E. Webb
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/3/09 appealing from the Office action mailed

2/6/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained

in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20020062485 A1	OKANO ET AL.	5-2002
20030199265 A1	AOYAMA ET AL.	10-2003
20020133573 A1	MATSUDA ET AL.	9-2002
6772420 B1	POGER ET AL.	8-2004
7096273 B1	MEIER	8-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention.

As to claim 1, excluding the mobile phone number as a device identifier is a negative

limitation that appears to have no support in the specification [see MPEP 2173.05(i),

Negative Limitations].

Additionally, the phrase "dynamically created by the server" is not supported by the

specification. The Examiner has previously shown that the Applicant's invention draws from

a pre-existing pool of "a set number of decimal or hexadecimal numbers, or even a set

number of characters and/or numbers" (see page 6, paragraph 17 of the previous Office

Action mailed on 3/25/08).

Furthermore, the amended limitation of "always associated with a same device

subsequent to allocation of the device identifier" raises new matter issues, as Applicant's own

specification explicitly goes against this limitation. The specification recites reusing device

identifiers for a plurality of devices if a time out occurs (Page 11, [0032], ln. 7-10).

As to claims 4 and 13, the device type not indicating the manufacturer is a negative

limitation that appears to have no support in the specification [see MPEP 2173.05(i),

Negative Limitations].

As to claims 10, 15, and 18, the claims are rejected using rationale similar to claim 1

above (with respect to the limitation of "always associated with a same device").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

Claims 1-2, 9-11, 14-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Okano et al. (Okano), U.S. Publication No. 2002/0062485 A1, in view of

Aoyama et al. (Aoyama), U.S. Publication No. 2003/0199265 A1.

As to claim 1, Okano discloses a method for assigning a device identifier to a device

(Abstract), the method comprising:

receiving a request for the device identifier at a server ([0084], ln. 1-5; [0088], ln. 1-4);

obtaining the device identifier ([0092]; temporarily allocated IP addresses are set), the

device identifier being unique from device identifiers of other devices of the server ([0170];

duplicate IP addresses are prevented), that is dynamically allocated by the server in response

to a request ([0002], DHCP is short for Dynamic Host Configuration Protocol, "dynamically

allocate an IP address"; [0092]; [0170]; DHCP dynamically allocates one of any number of IP

addresses from a pool and prevents duplicate addresses; the mere existence of a pool does not

mean the allocation of the device identifier is not dynamic, static simply means a set device

identifier is assigned to one device; rather, the allocation is dynamic, in that any of the

identifiers from the pool may be assigned, may be revoked if found to be a duplicate or

rejected by the client, and assignment is based on a lease time as opposed to statically set

permanently; clearly the fact that DHCP is called **Dynamic** Host Configuration Protocol,

DHCP being an extremely well known protocol, makes it clear that the definition of

dynamic as interpreted by the examiner is in line with the interpretations of those of

ordinary skill in the art);

marking a status of the device identifier as pending ([0092]; the IP addresses are set as

temporarily allocated, which is marking the device identifiers as pending);

sending the device identifier to the device ([0098]);

marking the status of the device identifier as in use after receiving an

acknowledgment from the device ([0099]; [0102]); and

sending a confirmation to the device after the acknowledgment is received ([0102];

[0110]).

Okano is silent on the device identifier being unrelated to a network address or host name of the device; and

the device is a wireless device that does not have a readily accessible device identifier or other communications related information.

However, Aoyama discloses the device identifier being unrelated to a network address or host name of the device ([0094]); and

the device is a wireless device that does not have a readily accessible device identifier or other communications related information ([0094]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Okano by obtaining a device identifier other than a network address or host name for a wireless device as taught by Aoyama in order to obtain a device identifier, such as a mobile phone number, to enable communications (Aoyama: [0094]).

As to claim 2, Okano and Aoyama disclose the invention substantially as in parent claim 1, including receiving a second acknowledgment from the device (Okano: [0110]-[0111]; [0149]-[0151]; it is inherent in and a standard feature of DHCP, which is taught by Okano, that a second acknowledgement is sent from a device to renew its lease); and

sending a second confirmation to the device (Okano: [0102]; [0110]-[0111]; [0147]-[0151]; it is inherent in and a standard feature of DHCP, which is taught by Okano, that a server sends a confirmation to renewal requests in the form of a DHCPACK message to extend a device's lease).

As to claim 9, Okano and Aoyama disclose the invention substantially as in parent claim 1, including reusing the device identifier for another request received from another device after a time out period has elapsed (Okano: [0200]); and

sending a rejection to the device if the acknowledgment is received after the time out period has elapsed (Okano: [0200]; the timed out subscriber terminal is disabled to use the IP address, which is a rejection).

As to claim 10, Okano discloses a method of obtaining a device identifier for a device (Abstract), the method comprising:

sending a request for the device identifier to a server ([0084], ln. 1-5; [0088], ln. 1-4), the device identifier being unique from device identifiers of other devices of the server ([0170]);

sending an acknowledgment to the server after receiving the device identifier from

the server ([0092]; [0098]-[0099]; [0102]; an acknowledgement is sent to the server in the

form of a DHCP request packet); and

using the device identifier after receiving a confirmation from the server ([0102];

[0110]-[0111]).

Okano is silent on the device identifier being unrelated to a network address or host

name of the device; and

the device is a wireless device that does not have a readily accessible device identifier

or other communications related information.

However, Aoyama discloses the device identifier being unrelated to a network

address or host name of the device ([0094]); and

the device is a wireless device that does not have a readily accessible device identifier

or other communications related information ([0094]).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Okano by obtaining a device identifier other than a

network address or host name for a wireless device as taught by Aoyama in order to obtain a

device identifier, such as a mobile phone number, to enable communications (Aoyama:

[0094]).

As to claim 11, Okano and Aoyama disclose the invention substantially as in parent claim 10, including a timestamp is also received from the server, and wherein the acknowledgment includes the device identifier and the timestamp (Okano: [0092]; [0110]-[0111]; a lease time is set, which is a timestamp).

As to claim 14, Okano and Aoyama disclose the invention substantially as in parent claim 10, including sending a second acknowledgment to the server if the confirmation has not been received after a time out period (Okano: Abstract; it is inherent in and a standard feature of DHCP, which is taught by Okano, that a second acknowledgement is sent to the server after a time out period).

As to claims 15 and 18, the claims are rejected for the same reasons as claim 1 above.

As to claims 16 and 19, the claims are rejected for the same reasons as claim 10 above.

As to claim 20, the claim is rejected for the same reasons as claim 9 above.

Claims 3-7, 12-13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okano and Aoyama as applied to claims 1, 10, and 15 above, in view of Matsuda et al.

(Matsuda), U.S. Publication No. 2002/0133573 A1, and with Poger et al. (Poger), U.S. Patent

No. 6,772,420 B1, providing intrinsic evidence for claims 4 and 13.

As to claim 3, Okano and Aoyama disclose the invention substantially as in parent

claim 1, but are silent on managing a set of device entries at the server, wherein each of the

set of device entries includes a device identifier, a status, and correlation data, and wherein

the request includes correlation data for the device.

However, Matsuda does disclose managing a set of device entries at the server ([0064],

ln. 1-4),

wherein each of the set of device entries includes a device identifier, a status, and

correlation data ([0064]; a MAC address and an IP address are device identifiers; a

name_in_use code is a status; a host name is correlation data), and

wherein the request includes correlation data for the device ([0065], ln. 1-7; a host

name is included in the request for configuration of the device).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Okano and Aoyama by managing a set of device entries

at a server, the device entries including a device identifier, a status, and correlation data and

by including correlation data for a device in a request as taught by Matsuda in order to

provide automatic configuration services for unadministered networks while being

automatically adaptable within administered environments (Matsuda, Abstract, ln. 4-7), in

order to enable a server to keep track of a device's MAC address and corresponding host

name and IP address (Matsuda, [0064]), and in order to allow a client to suggest desired

settings in a request (Matsuda, [0065], ln. 5-7).

     As to claims 4 and 13, Okano, Aoyama, and Matsuda disclose the invention

substantially as in parent claims 3 and 12, including the correlation data includes a device

type and user data (Matsuda: [0064]; [0065], ln. 1-7; a host name is user data; a MAC address

associated with a DHCP request is correlation data; it is inherent that a device type is

included in the correlation data as device type information is embedded in the MAC address,

which is in turn embedded in DHCP messages, see Poger, Col. 3, ln. 19-31 and Col. 4, ln. 48-

55).

     As to claim 5, Okano, Aoyama, and Matsuda disclose the invention substantially as in

parent claim 3, including each of the set of device entries further includes a timestamp, the

method further comprising setting the timestamp when the status is marked as pending

(Okano: [0092]; temporarily allocated IP addresses are made and lease times are set, which is

setting a timestamp when the status is marked as pending).

As to claim 6, Okano and Aoyama disclose the invention substantially as in parent claim 1, but are silent on providing correlation data at the server;

generating at least one device identifier based on the correlation data before the request is received;

marking the status of the generated at least one identifier as unused; and

locating one of the at least one device identifier having a status marked as unused after the request is received using the correlation data for the at least one device identifier and correlation data in the request.

However, Matsuda does disclose providing correlation data at the server ([0077]-[0078]; a preset address range is associated with clients requesting IP addresses from the DHCP server, wherein the preset address range at the DHCP server is correlation data at the server);

generating at least one device identifier based on the correlation data before the request is received ([0077]-[0078]; [0079], ln. 1-3; a maximum of 100 addresses is generated based on the preset address range);

marking the status of the generated at least one identifier as unused (Fig. 7, item 720); and

locating one of the at least one device identifier having a status marked as unused after the request is received using the correlation data for the at least one device identifier

and correlation data in the request (Fig. 7, items 704, 706, 708, and 720; [0065]; [0077]-

[0078]; an IP address that is not in use is located after the request is received; the preset

address range for the device identifier and the MAC address, desired IP address, and desired

host name in the request are used to configure the device, which is correlation data for the

device identifier and correlation data in the request).

     It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Okano and Aoyama by providing correlation data at a

server, generating device identifiers based on the correlation data before a request is

received, marking the device identifiers as unused, and locating an unused device identifier

using correlation data for the device identifier and correlation data in the request after the

request is received as taught by Matsuda in order to define a range of available client

addresses (Matsuda, [0077]), in order to allocate those client addresses (Matsuda, [0077]), in

order to define the addresses that the DHCP server can assign (Matsuda, [0079], ln. 1-3), and

in order to allow a client to suggest a desired IP address and ascertain if the IP address is

suitable (Matsuda, [0065], ln. 5-7 and 36-38).

     As to claim 7, Okano and Aoyama disclose the invention substantially as in parent

claim 1, but are silent on generating a device identifier after receiving the request using

correlation data in the request.

However, Matsuda does disclose generating a device identifier after receiving the

request using correlation data in the request (Fig. 7, items 704, 706, and 708; [0065]; a device

identifier is generated using the MAC address, desired IP address, and desired host name in

the request, which is correlation data in the request).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Okano and Aoyama by generating a device identifier

after receiving a request using correlation data in the request as taught by Matsuda in order

to allow a client to suggest desired settings in a request (Matsuda, [0065], ln. 5-7).

As to claim 12, Okano and Aoyama disclose the invention substantially as in parent

claim 10, but are silent on the request includes correlation data.

However, Matsuda does disclose the request includes correlation data ([0065], ln. 1-7;

a desired host name is included in the request, which is correlation data in the request).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Okano and Aoyama by including correlation data in a

request as taught by Matsuda in order to allow a client to suggest desired settings in a request

(Matsuda, [0065], ln. 5-7).

As to claim 17, Okano and Aoyama disclose the invention substantially as in parent claim 15, but are silent on a management system for managing a set of device entries, wherein each of the set of device entries includes a unique device identifier, a status, and correlation data, wherein the request includes correlation data for the device; and

a comparison system for obtaining one of the set of device entries based on correlation data for the device.

However, Matsuda does disclose a management system for managing a set of device entries ([0064], ln. 1-4),

wherein each of the set of device entries includes a unique device identifier, a status, and correlation data ([0064]; a MAC address and IP address are unique device identifiers; a name_in_use code is a status; a host name is correlation data),

wherein the request includes correlation data for the device ([0065], ln. 1-7; a host name is included in the request for configuration of the device); and

a comparison system for obtaining one of the set of device entries based on correlation data for the device (Fig. 7, items 704, 706, and 708; [0065]; the desired IP address in the request is used to obtain an IP address, which is correlation data for the device).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Okano and Aoyama by managing a set of device entries at a management system, the device entries including a unique device identifier, a status, and

correlation data and by including correlation data for a device in a request as taught by

Matsuda in order to provide automatic configuration services for unadministered networks

while being automatically adaptable within administered environments (Matsuda, Abstract,

ln. 4-7), in order to enable a management system to keep track of a device's MAC address and

corresponding host name and IP address (Matsuda, [0064]), in order to allow a client to

suggest desired settings in a request to obtain an IP address (Matsuda, [0065], ln. 5-7), and in

order to obtain an IP address so that a device may communicate across an IP network or

networks.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okano and

Aoyama as applied to claim 1 above, in view of Meier, U.S. Patent No. 7,096,273 B1.

As to claim 8, Okano and Aoyama disclose the invention substantially as in parent

claim 1, but are silent on marking the status of the device identifier as unused if the

acknowledgment is not received after a time out period.

However, Meier does disclose marking the status of the device identifier as unused if

the acknowledgment is not received after a time out period (Col. 2, ln. 8-15).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Okano and Aoyama by marking a device identifier as

unused if an acknowledgement is not received after a time out period as taught by Meier in

order to put the device identifier back into a pool ready to be re-used (Meier, Col. 2, ln. 13-

15).

(10) Response to Argument

- **Argument 1** (see pages 5-6 of the appeal brief)

Appellant argues the limitation "unrelated to a network address, mobile phone

number or host name of the device" is not an unsupported negative limitation as it is

supported by Fig. 7 of the drawings and therefore not properly rejected under 35 U.S.C. 112,

first paragraph. The argument is that Fig. 7 shows the DEV ID as being none of a network

address, a mobile phone number, or a host name of a device.

- **Examiner's Response to Argument 1**

The Examiner maintains that the mere absence of the types of identifiers explicitly

does not limit them from being interpreted as the identifier for the purposes of a prior art

rejection. The form of the ID in Fig. 7 may be interpreted as an example of an identifier, but

does not necessarily indicate an attempt by the Appellant to limit all others from being used

in the claimed embodiment(s).

Furthermore, as stated in the final Office action mailed on 2/6/09: "As to claims 1, 4,

and 13, Applicant argues against the 35 U.S.C. 112, first paragraph rejections and points to

Fig. 7 of the specification as support for the negative limitations. The mere disclosure of a

form of the ID does not exclude other forms unless they are explicitly excluded by language

in the specification. Nowhere in the specification does Applicant indicate that the material

seeking to be patented is to be limited to the narrow type of identifier seen in Fig. 7." (Page

2, paragraph 3 of the final Office action).

- **Argument 2** (see pages 6-7 of the appeal brief)

Appellant argues the cited references fail to teach or suggest the device identifier

being "dynamically created" as the addresses in the prior art are drawn from a pre-existing

pool.

- **Examiner's Response to Argument 2**

Firstly, the Examiner points out that the language in question is also being rejected

under 35 U.S.C. 112, first paragraph as not being supported by the written description (see

the corresponding rejection in the grounds of rejection section). The Examiner stated the

following in the final Office action and maintains his position: "As to claim 1, Applicant

argues the device identifiers are not dynamically created as they are drawn from a pre-

existing pool. The Examiner has previously shown that the Applicant's invention also draws

from a pre-existing pool of "a set number of decimal or hexadecimal numbers, or even a set

number of characters and/or numbers" (see page 6, paragraph 17 of the previous Office

Action mailed on 3/25/08). Therefore, 35 U.S.C. 112, first paragraph (new matter) issues are

raised by the amended limitation." (Page 2-3, paragraph 4 of the final Office action).

Accordingly, the Examiner maintains his position that the Appellant's own

embodiment is drawing from a finite number of possible addresses drawn a pre-existing set

number of decimal or hexadecimal numbers, or even a set number of characters and/or

numbers (as shown in Fig. 7 of the Appellant's drawings). Therefore, the claim is rejected

using the previous language of "dynamically allocating" the identifiers as rejected in the

corresponding prior art rejection of claim 1 in the grounds of rejection above.

- **Argument 3** (see page 7 of the appeal brief)

Appellant argues the address assigned in Okano is a network address and not

unrelated to a network address, mobile phone number or host name of the device.

- **Examiner's Response to Argument 3**

The language at issue has been rejected under 35 U.S.C. 112, first paragraph as

discussed above. Additionally, Aoyama discloses a portion of the unsupported language as it

discloses the identifier being unrelated to a network address or host name of a device

([0094]). The identifier being unrelated to a network address or host name of a device was

amended into the claim in response to Okano's disclosure to a prior art rejection. In response

to the new citation of Aoyama in response to this negative limitation, Appellant then further

amended the claim to read that the identifier was unrelated to a mobile phone number (in

attempt to avoid Aoyama's use of a mobile phone number). However, as mentioned, each

further limitation appears to be a negative limitation in response to the Examiner's finding of

prior art.

- **Argument 4** (see pages 7-8 of the appeal brief)

Appellant argues the cited references fail to disclose a device type that is not

manufacturer and user data.

- **Examiner's Response to Argument 4**

Appellant has failed to respond to the language of claim 4 being rejected under 35

U.S.C. 112, first paragraph. The language also is a negative limitation that appeared to be in

response to a prior art rejection by the Examiner. Therefore, the Examiner maintains that the

claim is properly rejected using the form of the claim that appeared prior to the introduction

of the negative limitation (i.e., see the version of claim 4 in the amendment filed 10/11/07,

which introduces the negative limitation).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Brian P. Whipple

/B. P. W./

Examiner, Art Unit 2452

11/11/09

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